

**REMARKS**

This paper is filed in response to the Office action dated November 27, 2009, in which all pending claims 1-13 are rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter, but are otherwise allowable if rewritten or amended to overcome the §101 rejection. Additionally, claim 8 is rejected and objected to for reciting undefined abbreviation and for lacking antecedent basis. In response, Applicant has amended claim 1, which is properly supported by page 8, line 20 to page 9, line 3 of the specification. Applicant has also amended claim 8 so that the recited abbreviation is well-defined and does not need antecedent basis. No new matter is added. In light of the amendments and remarks submitted herewith, reconsideration and withdrawal of the §101 rejection are respectfully requested.

First, claims 1-6 are rejected for being directed to non-statutory subject matter in light of the Deputy Commissioner's memorandum dated May 15, 2008, entitled "Clarification of 'Processes' under 35 U.S.C. §101," which requires a statutory process to either (1) be tied to another statutory class (such as a particular apparatus) *or* (2) transform underlying subject matter (such as an article or material) to a different state or thing. By way of this amendment, Applicant has amended independent claim 1, upon which claims 2-6 depends, to tie each of the recited steps to a particular apparatus, namely, a radio sender, a seal calculation module, and a channel coder, all of which are sufficiently described in the specification. As a result, the §101 rejection of claims 1-6 is overcome and therefore should be withdrawn.

Turning to claims 7-13, the Examiner appears to have interpreted the means-plus-function claims as process claims and rejected them under §101, either because "the method steps ... can be practiced mentally in conjunction with pen and paper" or because the claims do not "define a machine or computer implemented process." See Office action at page 3. Applicant disagrees. In particular, Applicant wants to remind the Examiner that similar means-plus-function claims were recently upheld in *Ex Parte Verhaegh*, Appeal 2009-000128 (BPAI 2009), as discussed in greater detail below.

The application in *Verhaegh* is directed to a method of determining a schedule for executing a plurality of tasks requiring a plurality of resources, and the claims are directed

towards creating a schedule for tasks using project management techniques. In particular, claim 6 recites the scheduler with the following means-plus-function limitations:

A scheduler for determining a schedule for executing a plurality of tasks requiring a plurality of resources, comprising:

constructing means for constructing a set of constraints from given requirements of each task and from given limitations on each resource;

ordering means for determining for each task a relative starting time, a relative ending time and an assignment of resources, based on the constraints from said set;

timing means for determining for each task an absolute starting time, an absolute ending time and a collection of times and associated task processing speeds, based on the determined relative starting time, relative ending time and assignment of resources for said task, minimizing any violation of the constraints from said set; and

scheduling means for determining the schedule, comprising for each task the determined absolute starting time, absolute ending time, collection of times and associated task processing speeds and assignment of resources to said task.

The Examiner interpreted this means-plus-function claim as a process and rejected it under §101. Specifically, the Examiner found that the scheduler did not fall within one of the four statutory categories and that it is no more than a software module that is not embedded on a computer readable medium or executable by a computer, and therefore should be interpreted as a process claim.

The Appellant argued, and the Board agreed, that claim 6 should not be interpreted as a process claim because the specification links the scheduler to various systems in order to determine a schedule for executing tasks. In reaching this conclusion, the Board reasoned that:

Claim 6 . . . recites four elements in means plus function format. Thus, each of these means are presumed to require construction under 35 U.S.C. § 112, sixth paragraph. None of the four elements recite structural limitations to the means in the claims. Thus we conclude these elements are to be construed as means plus function, implying the claim is directed to a machine. Looking at the claim as a whole, the claim is directed to a scheduler. The Specification discloses a scheduler as being part of a digital video transmission system (FF 01). Thus the claim is directed to a particular machine, viz. a digital video transmission system. *Ex Parte Verhaegh*, pages 13-14, Appeal 2009-000128 (BPAI 2009), emphasis added.

Here, claims 7-13 should be construed as means-plus-function claims under 35 U.S.C. 112, sixth paragraph because no structural limitation is recited to the means elements and

because claims 7-13, as a whole, are clearly directed to a transmitting device which is a part of a radiocommunication system according to the specification (page 5, line 27 to page 6, line 6). Thus, under *Verhaegh*, claims 7-13 of this application are directed to a particular machine, which is sufficiently described in the specification. Moreover, because claims 7-13 are directed to a machine and not a process, we do not need to address the Examiner's argument that "the method steps ... can be practiced mentally in conjunction with pen and paper." Applicants respectfully submit that the rejection of claims 7-13 under 35 U.S.C. §101 is improper under *Verhaegh* and therefore should be withdrawn as well.

In light of all the foregoing, Applicant respectfully submits that each of the currently pending claims is in a condition for allowance and respectfully solicits same. If a telephone call would expedite prosecution of the subject application, the Examiner is invited to call the undersigned agent.

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Respectfully submitted,

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